

### **REMARKS**

This responds to the Office Action mailed on December 5, 2007.

Claims 4 and 15 are amended, no claims are canceled, and no claims are added; as a result, claims 1-15 are now pending in this application.

#### **§112 Rejection of the Claims**

Claims 4 and 15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention<sup>1</sup>. Applicant respectfully disagrees but, nevertheless, amends claims 4 and 15 to more clearly define the invention.

The Office Action contends that “potential” is possibility of action and it is uncertain that steps following “potential” are executed , which makes scope of the claim indefinite.<sup>2</sup> Applicant respectfully disagrees.

#### *Claim 4 (original) recites:*

“A computer program having the potential, when run on a system, including a receiver and a subscriber secure device, connected to the receiver through an interface, to enable the system to execute a method according to claim 2.”

#### *Claim 15 (original) recites:*

“A computer program having the potential, when run on a terminal including a client secure device and a user interface, to provide the system including the terminal and the client secure device with the functionality of a terminal according to claim 7.”

The Board of Patent Appeals and Interferences has stated:

In rejecting a claim under the second paragraph of 35 U.S.C. §112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims.<sup>3</sup>

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<sup>1</sup> Non-final Office Action, Page 2

<sup>2</sup> Non-final Office Action, Page 2

<sup>3</sup> Ex parte Wu, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989)(citing In re Moore, 439 F.2d 1232, 169 USPQ 236 (C.C.P.A. 1971); In re Hammack, 427 F.2d 1378, 166 USPQ 204 (C.C.P.A. 1970)).

The M.P.E.P. adopts this line of reasoning, stating that:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. M.P.E.P. § 2173.02”

Applicant respectfully submits that the claim language in question, when analyzed in light of the content of the application disclosure, is not indefinite. Claims 4 and 15 are essentially computer-readable claims commonly referred to as Beauregard claims. Beauregard claims cover a computer-readable storage device, e.g., a floppy disk or CD, containing a set of instructions that causes a computer to perform a process. *In re Beauregard*<sup>4</sup>, the Federal Circuit upheld a computer program as patentable subject matter. The Office Action contentions that claims 4 and 15 are indefinite under 35 U.S.C. § 112 due to an uncertainty as to whether the method will be executed are incorrect because an execution of a computer program is always conditional.

Applicant respectfully submits that a person of ordinary skill in the pertinent art, when reading claims 4 and 15 in light of the supporting specification would ascertain that claims 4 and 15 refer to computer programs comprising instructions, which when implemented by a computer processor, perform the operations of the method described in claims 2 and 7, respectively.

Applicant respectfully submits that the rejection of claims 4 and 15 under 35 U.S.C. § 112 is improper and that claims 4 and 15 should be allowable as amended.

As amended claims 4 reads:

“A computer program, when run on a system, including a receiver and a subscriber secure device, connected to the receiver through an interface, to enable the system to execute a method according to claim 2.”

As amended claims 15 reads:

“A computer program, when run on a terminal including a client secure device and a user interface, to provide the system including the terminal and the client secure device with the functionality of a terminal according to claim 7.”

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<sup>4</sup> 53 F.3d 1583 (Fed. Cir. 1995).

Applicant respectfully requests withdrawal of the rejections of claims 4 and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite in light of the arguments and the amendments made.

§102 Rejection of the Claims

Claims 1-3, 5-12 and 14 were rejected under 35 U.S.C. § 102(e) for anticipation by Novak et al. (United States Patent Application Publication 2003/0097655). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.<sup>5</sup>

Concerning claim 1:

This rejection is respectfully traversed, Applicant respectfully submits that the Office Action has made an improper *prima facie* showing of anticipation at least because Novak fails to teach "the system having the capability to create a transaction token, incorporating a first code uniquely identifying the subscriber secure device, wherein the receiver is programmed to make the first code available on the display device, and the system further includes a terminal for creating a transaction token, including an interface to a client secure device, wherein the terminal includes a user interface for entering the first code, and is arranged to create the transaction token from the entered first code in co-operation with the client secure device".

Claim 1 recites (in part):

“...the system having the capability to create a transaction token, incorporating a first code uniquely identifying the subscriber secure device, wherein the receiver is programmed to make the first code available on the display device, and the system further includes a terminal for creating a transaction token, including an interface to a client secure device, wherein the terminal includes a user interface for entering the first code, and is arranged to create the transaction token from the entered first code in co-operation with the client secure device”

Applicant respectfully submits that claim 1 includes “a display device” utilized “to make first code available” and a “terminal” that includes “a user interface for entering

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<sup>5</sup> *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

the first code” in order to create “a transaction token”. In contrast, Novak relates to providing conditional access to digital content that associates a license to view the content with a particular user, and allows that user to convey at least a portion of his or her license to another user. Furthermore, Novak relates to digital content distribution system and method that approximates the loaning or selling physical articles, such as a book, CD, or DVD.

The Office Action, referring to Figure 4 of Novak and corresponding description in paragraphs 82, contends that “system having the capability to create a transaction token” is disclosed. Applicant respectfully disagrees.

Figure 4 of Novak is shown below.

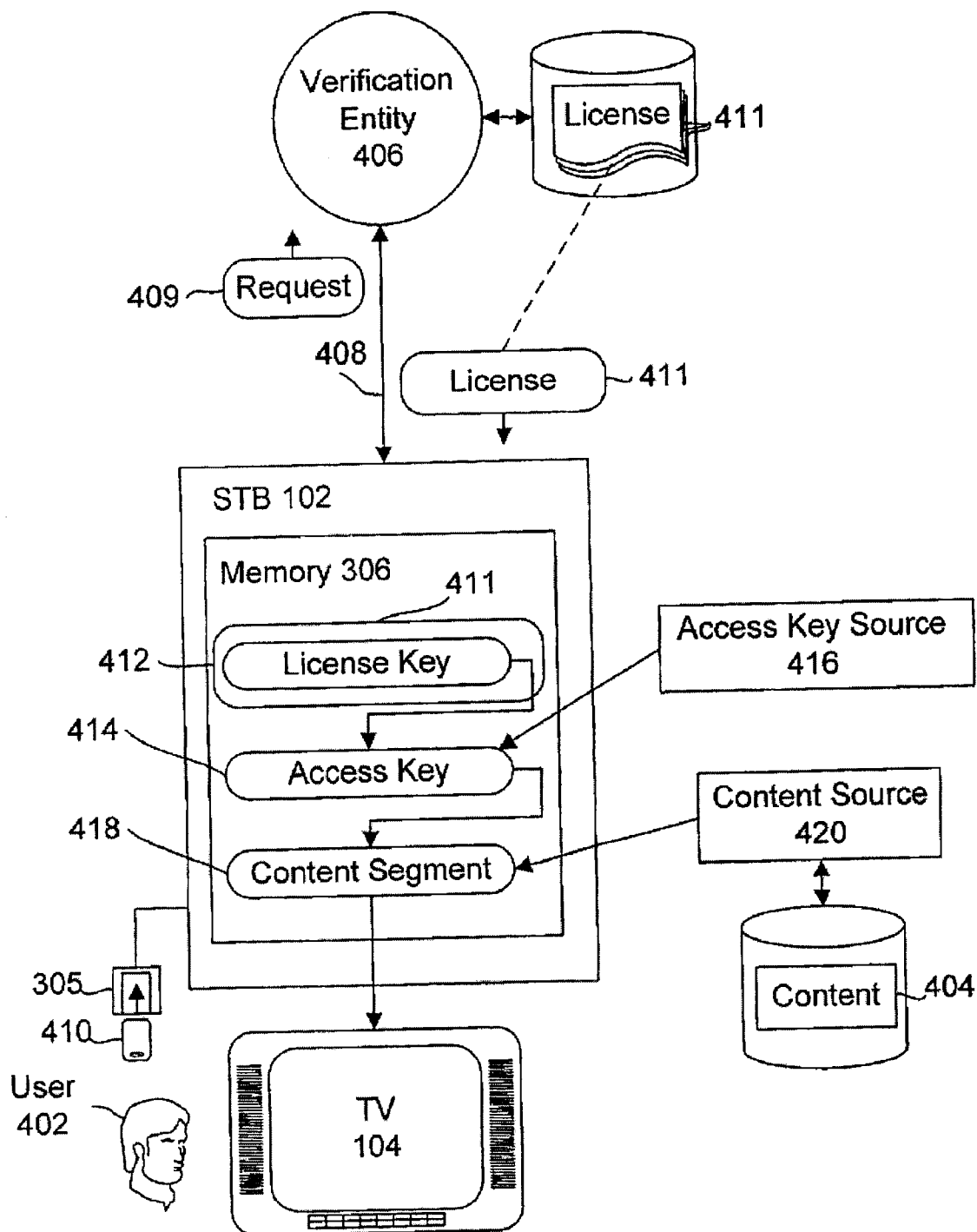


FIG. 4

Paragraph 82 of Novak recites:

“Referring now to FIG. 4, a user 402 may desire to view or listen to a specific program of digital content 404, such as a movie, television show, musical performance, etc. In one embodiment, the user 402 specifies the desired content 404 via a user interface (not shown) displayed on the television 104. For example, the user 402 may select from a displayed list of pay-per-view (PPV) movies or the like.”

The Office Action contends that “user 402 specifies the desired content 404 via a user interface displayed on the television 104” discloses “system having the capability to create a transaction token”. Applicant respectfully submits that specifying the desired content cannot be reasonably equated with a “transaction token”. Applicant further submits that Novak cannot be reasonably understood to anticipate independent claim 1 because independent claim 1 is directed to a “transaction token created on a terminal” that includes “a user interface for entering the first code” and not on a “display device” utilized “to make first code available”. Figure 4 of Novak shows that the content 404 that can be displayed on the TV 104. Applicant agrees that the TV 104 may serve as a “display device”. However, no “terminal” that includes “a user interface for entering the first code” is shown or described in Novak.

The Office Action further contends that “first code uniquely identifying the subscriber secure device, wherein the receiver is programmed to make the first code available on the display device” is disclosed in paragraphs 89 and 112. Applicant respectfully disagrees.

Paragraph 89 of Novak recites:

“In certain embodiments, the authentication process may require the user 402 to enter additional information via the remote control 106 or keyboard 108, such as a pass code or pass phrase, which is likewise sent to the verification entity 406 with or following the request 409. In addition, the user may need to have current biometric data scanned by a biometric reading device (not shown), such as a fingerprint or retinal scanner, which is also sent with or following the request 409 for verification purposes.”

Paragraph 112 of Novak recites:

“FIG. 6 illustrates further details of the above described process from the standpoint of the verification entity 406. As previously noted, the request 409 may include a user identifier 602 (which may include identity credentials) and a content identifier 604. In one embodiment, the user identifier 602 uniquely

identifies the user 402, while the content identifier 604 uniquely describes or identifies the requested content 404. For example, the request 409 may include a personal network address (e.g., ENUM address), user identifier, or e-mail address unique to the user 402, as well as a serial number or title of a particular program of digital content 404.”

The Office Action contends that requiring a user to enter a pass code or pass phrase and “first code uniquely identifying the subscriber secure device, wherein the receiver is programmed to make the first code available on the display device” is one and the same. Applicant respectfully submits that the language of Novak cited by the Office Action refers to a entirely different concept. In Novak, a user is required to enter a pass code in order to access the subscriber secure device, whereas, in independent claim 1, “the receiver is programmed to make the first code available on the display device”.

The Office Action further contends that Novak, in paragraphs 74 and 89 discloses “the system further includes a terminal for creating a transaction token, including an interface to a client secure device, wherein the terminal includes a user interface for entering the first code, and is arranged to create the transaction token from the entered first code in co-operation with the client secure device.” Applicant respectfully disagrees.

Paragraph 74 of Novak recites:

“The STB 102 may include or be coupled to a smart card reader 305 for accessing digital information stored within a smart card or similar device. A smart card is a non-volatile memory device that may include, for instance, a microprocessor. A variety of smart card readers 305 and associated media are available, which are well known to those skilled in the art. In one embodiment, the smart card reader 305 is used to read identification credentials, such as digital signatures, digital certificates, pass codes, pass phrases, biometric data, or the like, from a user's smart card in order to authenticate the user for viewing requested digital content. Of course, a smart card reader 305 is not required in every embodiment.”

Paragraph 89 of Novak recites:

“In certain embodiments, the authentication process may require the user 402 to enter additional information via the remote control 106 or keyboard 108, such as a pass code or pass phrase, which is likewise sent to the verification entity 406 with or following the request 409. In addition, the user may need to have

current biometric data scanned by a biometric reading device (not shown), such as a fingerprint or retinal scanner, which is also sent with or following the request 409 for verification purposes.”

According to the Office Action, entering additional information via the remote control 106 or keyboard 108 reads on “terminal for creating a transaction token” and entering a pass code reads on “terminal includes a user interface for entering the first code”. It is argued above that “the first code” of independent claim 1 is not disclosed in Novak because it must be made available by “a display device” and not entered by the user. Furthermore, a remote control is a mere input device to the TV 104 and not to “a user interface” of the “terminal” in independent claim 1.

For at least the reasons stated above, Novak fails to disclose all limitations of independent claim 1, and therefore the rejection of claim 1 as anticipated by Novak is improper and should be reconsidered and withdrawn.

Concerning claim 2:

This rejection is respectfully traversed, Applicant respectfully submits that the Office Action has made an improper *prima facie* showing of anticipation at least because Novak fails to teach " wherein a first code for creating a transaction token, uniquely identifying the subscriber secure device, is made available to the user on the display device".

Claim 2 recites:

“ ... A method of enabling a transaction, in a system including a head-end, a communications network, and a receiver, capable of receiving digital information, including content data, from the head-end through the network and of making the content data available to a user on a display device, which receiver further includes an interface to a subscriber secure device, wherein a first code for creating a transaction token, uniquely identifying the subscriber secure device, is made available to the user on the display device.”

The Office Action contends that Novak in paragraph 82, 89 and 112 (all cited above) disclose “wherein a first code for creating a transaction token, uniquely identifying the subscriber secure device, is made available to the user on the display



device". Applicant respectfully disagrees.

The Office Action contends that Novak discloses specifying desired content via a user interface displayed on the television, which reads on "first code for creating a transaction token"<sup>6</sup>. Applicant respectfully submits that Novak cannot be reasonably understood to disclose cited element of independent claim 2 because the desired content in Novak is something that a user has access to upon providing some kind of identification. In contrast, independent claims 2 recites "a first code for creating a transaction token, uniquely identifying the subscriber secure device, is made available to the user on the display device".

The Office Action further contends that a user identifier of Novak reads on "uniquely identifying the subscriber secure device". Applicant respectfully submits that a user identifier is something identifying the user and not "the subscriber secure device".

For at least the reasons stated above, Novak fails to disclose all limitations of independent claim 2, and therefore the rejection of independent claim 2 as anticipated by Novak is improper and should be withdrawn.

Concerning claims 3-4 and 6:

Applicant respectfully submits that dependent claims 3-4 and 6 depend directly or indirectly from independent claim 2. As such, each of these dependent claims incorporates all the limitations of its parent independent claim. Accordingly, Applicant respectfully submits that these dependent claims are patentable for at least the reasons set forth above.

Thus, Applicant respectfully requests withdrawal of the rejections of claims 3-4 and 6. For brevity, Applicant reserves the right to present further remarks concerning the patentable distinctiveness of the features of such dependent claims.

Concerning claim 7:

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<sup>6</sup> Non-final Office Action, Page 7

This rejection is respectfully traversed, Applicant respectfully submits that the Office Action has made an improper prima facie showing of anticipation at least because Novak fails to teach "a terminal for creating a transaction token".

Claim 7 recites:

"... A terminal for creating a transaction token, including an interface to a client secure device, and arranged to create a transaction token incorporating a first code, identifying a subscriber secure device, wherein the terminal includes a user interface for entering the first code, and is arranged to create the transaction token from the entered first code in co-operation with the client secure device."

The office Action contends entering additional information via the remote control or keyboard such as pass code or pass phrase reads on "a terminal for creating a transaction token". Applicant respectfully submits that a remote control is a mere input device to a display device but not a "terminal" cited in independent claim 7.

Concerning claims 8-12 and 14:

Applicant respectfully submits that dependent claims 8-12 and 14 depend directly or indirectly from independent claim 7. As such, each of these dependent claims incorporates all the limitations of its parent independent claim. Accordingly, Applicant respectfully submits that these dependent claims are patentable for at least the reasons set forth above.

Thus, Applicant respectfully requests withdrawal of the rejections of claims 8-12 and 14. For brevity, Applicant reserves the right to present further remarks concerning the patentable distinctiveness of the features of such dependent claims.

§103 Rejection of the Claims

Concerning claims 4 and 15:

Claims 4 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak.

The Office Action expressly concedes that Novak fails to disclose computer readable medium of claims 4 and 15. To cure this deficiency, the Examiner “takes official notice of the fact that it was well known in the art to provide a computer readable medium”<sup>7</sup>.

Claims 4 and 15 are not obvious because Novak even when combined with the official notice (assuming, *arguendo*, the official notice is correct) fails to describe or suggest all of the limitations of claims 4 and 15. Applicant believes they have established that Novak fails to disclose all of the subject matter included in independent claims 2 and 7, and, accordingly, Novak also fails to disclose all of the limitation of claims 4 and 15, which indirectly depends from independent claims 2 and 7. Thus, Novak and the official notice fail to describe or suggest the subject matter included in independent claims 2 and 7, and so claims 4 and 15 which are indirectly dependent on independent claims 2 and 7, are not obvious in view of the proposed combination of Novak and the official notice.

Thus, because not all elements of claims 4 and 15 are found in Novak and the official notice fails to cure this deficiency of Novak, Applicant respectfully submits that the Office Action has failed to present a *prima facie* case of obviousness and they respectfully request reconsideration and withdrawal of this rejection.

Concerning claim 13:

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak, in view of Hendricks et al. (United States Patent No. 7,134,131).

The Office Action expressly concedes that Novak fails to disclose “the terminal is arranged to receive a confirmation of the transaction from the arbitrary system, and has the capability of indicating receipt of the confirmation to the user” of claim 13. To cure this deficiency, the Office Action apparently relies on Hendricks.

Claim 13 is not obvious in view of the proposed combination of Novak and Hendricks because the proposed combination fails to describe or suggest all of the limitations of claim 13. Applicant believes they have established that Novak fails to disclose all of the subject matter

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<sup>7</sup> Non-final Office Action, Page 16

included in independent claim 7, and, accordingly, Novak also fails to disclose all of the limitation of claim 13, which indirectly depends from independent claim 7. Furthermore, Applicant fails to find, and the Office Action fails to point out in Hendricks, where there is a description or a suggestion of the subject matter of claim 7 missing from Novak. Thus, the proposed combination of Novak and Hendricks fails to describe or suggest the subject matter included in 7, and so claim 13 which is indirectly dependent on independent claim 7, is not obvious in view of the proposed combination of Novak and Hendricks.

Thus, because not all elements of claim 13 are found in Novak and Hendricks fails to cure this deficiency of Novak, Applicant respectfully submits that the Office Action has failed to present a *prima facie* case of obviousness and they respectfully request reconsideration and withdrawal of this rejection.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4051 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.

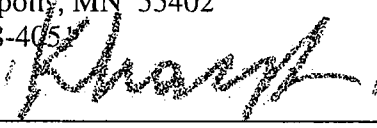
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Date March 5, 2008

By

  
Georgiy L. Khayet

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